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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,301	07/12/2006	Christopher R. Trotta	10589-013-999	4617
20583	7590	01/16/2009		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER LUNDGREN, JEFFREY S	
			ART UNIT 1639	PAPER NUMBER
			MAIL DATE 01/16/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,301

**Applicant(s)**

TROTTER, CHRISTOPHER R.

**Examiner**

JEFFREY S. LUNDGREN

**Art Unit**

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 55-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 55-90 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 55-58, 63-74, 75 (in-part), 77 (in-part), 78 (in-part), and 79-82, are drawn to a method for identifying a compound that modulates animalia tRNA, involving a detecting step with a cleavage step.

Group II, claims 59-62, 75 (in-part), 76, 77 (in-part) and 78 (in-part), are drawn to a method for identifying a compound that modulates animalia tRNA, with a detecting step involving a reporter gene.

Group III, claims 83-90, are drawn to a method for treating cancer with the compounds identified by the method of Group I.

For the rules governing a lack of unity determination, see 37 C.F.R. § 1.475 – *Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage* (especially paragraphs (a), (c) and (d)).

- (a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
- (b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
  - (1) A product and a process specially adapted for the manufacture of said product; or
  - (2) A product and process of use of said product; or
  - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
  - (4) A process and an apparatus or means specifically designed for carrying out the said process; or
  - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

- (c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.
- (d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).
- (e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

In the instant case, the method of Groups I and II lack unity of invention because the methods are directed to multiple processes of use as defined by 37 C.F.R. § 1.475(d), and do not share a special technical feature that defines over the art.

### *Election of Species*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- A. *the compound that alters tRNA splicing activity and the direction of the "alteration"* – Applicants are required to elect a single compound within the scope of the invention that alters tRNA splicing activity (e.g., see claims 56 and 57), and are required to elect an increase or decrease in activity; Applicants may elect an "unidentified" or "generic" or "non-descript" compound if the compound is merely intended to be a means to capture a claimed method from a library of compounds, and not meant to be limited to a chemical structure;
- B. *the sample for analysis* – Applicants are required to elect a single sample for analysis, for example, a cell-free extract (e.g., claim 70), a cell (e.g., claim 72), purified form of tRNA splicing endonuclease (e.g., claim 71);
- C. *the substrate* – Applicants are required to elect a single substrate, such as one of the substrates identified in step (a) of claim 55;

- D. *the fluorescence detection scheme* – Applicants are required to elect a single fluorescence detection scheme, *i.e.*, the donor-acceptor probes used, and the relationship of the change in fluorescence upon detection, such as an increase or decrease (*e.g.*, see claims 73 and 74);
- E. *the tRNA splicing endonuclease* – Applicants are required to elect a single tRNA splicing endonuclease, such as, animalia or fungal (see claims 73 and 74).

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each of the species is functionally distinct from each of the other species, and has a different mode of action.

#### ***Correction of Inventorship***

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Time for Reply***

Applicant is reminded that 1-month (not less than 30 days) shortened statutory period will be set for reply when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program. M.P.E.P. § 809.02(a).

***Conclusions***

If Applicants should amendment the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the amendment is not supported *in ipsis verbis*, clarification on the record may be helpful). Should Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low, can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey S. Lundgren/  
Patent Examiner, Art Unit 1639